



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO : 09/777,212
CONFIRM. NO. : 3030
APPLICANT : Wyker, Kenneth S.
FILED : February 5, 2001
ART UNIT : 3622
EXAMINER : Duran, Arthur D.
DOCKET NO : 146/1
CUSTOMER NO : 36829
FOR : BUSINESS METHOD FOR INFLUENCING CONSUMER
PURCHASE OF RETAIL SALES ITEMS

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Examiner's Office Action dated November 3, 2004. Claims 1-41 in the case are pending. Claims 1-5, 7-21, 23-31, and 33-41 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Deaton ('322) in view of Kepecs ('543). Claims 6, 22, and 32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Deaton ('322) in view of Kepecs ('543), and further in view of Barnett ('208).

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on December 21, 2004.

Kristen Salgado
Kristen Salgado

December 21, 2004
Date

In two prior interviews with Examiners Arthur Duran and James Myhre, written responses and claim amendments, Applicant has effectively distinguished its novel business method from the art cited—namely, Deaton and Kepecs. Applicant has nearly 20 years of experience in the retail grocery industry from both a manufacturer and retailer perspective, and is well aware of the couponing/discount programs discussed in this prior art. During each interview, the examiners were given an explanation of the invention and various known couponing/discount programs, and discussed with Applicant certain claim language which was believed to more effectively describe and distinguish the invention. In each case, the suggested claim language was incorporated into amended claims. Regrettably, despite these claim amendments, all claims of the present RCE stand rejected—a first action rejection which has been improperly made *Final*. This most recent rule error by the examiner is but one of several events demonstrating an unfortunate pattern of poor case handling and an apparent misapplication of the standards for patentability. The chronology of events is outlined below:

- ▶ In his first interview, Applicant discussed the couponing/discount programs of Deaton and noted certain limitations from a manufacturer's perspective in the inability of the manufacturer to effectively control and manipulate net sales price of items to consumers based on current pricing activity within particular retail stores. This distinction and appropriate claim amendments were discussed at length during this first interview. Specifically, the examiners suggested refocusing the original claims on the *activity and control of the manufacturer—namely, the manufacturer offering a price discount to a predetermined select group of consumers based on the promotion period of an item at the retail stores and the purchase history of the consumers*. This claim amendment was made in Applicant's first response.

- ▶ In a second Office Action, Examiner Duran maintained an obviousness rejection based on the previously cited Deaton patent (discussed during the first interview) in view of a secondary reference; Kepecs. The disclosure of Deaton was further discussed

at length with Examiners Duran and Myhre in a second personal interview at the Patent and Trademark Office. Through his many years of experience in the industry, Applicant noted his familiarity with programs similar to those described in Deaton, and explained to the examiners how these programs fail to teach or suggest the concept of the present claimed invention—that of coordinating manufacturer price discounts for select consumers based on retail price reductions at individual retail stores. During this second interview, the examiners suggested another amendment to the claims in order to further clarify the coordinated activity of the manufacturer—specifically, that manufacturer price discounts are being offered to select consumers at individual retail stores based on the store's promotion period. In view of this indication by the examiners, the claims were again amended in Applicant's second response.

- ▶ In response to this further amendment, Examiner Duran issued an *Advisory Action* stating that the suggested claim language *raised new issues of patentability* and would not be entered. This added claim language was identical to that discussed with the examiners during the second interview. At no point during this interview did either examiner indicate that such an amendment would be refused entry.

- ▶ In view of the *Advisory Action*, Applicant filed the present RCE with a request that the previous non-entered claim amendments be considered.

- ▶ In his first Office Action for the RCE, Examiner Duran repeated his earlier rejection of the claims based on Deaton and Kepecs. This rejection was made Final.

Despite Applicant's many years of experience in this industry, his extensive knowledge of past and present couponing/discount programs of both manufacturers and retailers, his explanation of the various programs described in the art cited (namely, Deaton) in two separate personal interviews, and the claim amendments, the examiners have chosen to maintain an *obviousness* rejection based on what they believe is taught and/or suggested in this prior art. This "piecing together" of *isolated features* described in Deaton and Kepecs, whether implicitly or explicitly, is a clear misapplication of the standard

for patentability established by Section 103¹. As evidenced by the case history discussed above, the examiners have overstepped the bounds of discretion in their persistent efforts to deprecate the claimed invention through hindsight reconstruction. In making an obviousness rejection, it is *not proper* to start with knowledge of what the application discloses and to use that as a basis to evaluate what, if anything, the prior art discloses that would have been helpful to achieve the claimed invention. See *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). In other words, the disclosure of the application may not be used as a guide to select and piece together various teachings of the prior art to show that an invention was obvious. See *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991). The ease or difficulty of making the invention must be evaluated in terms of the state of knowledge as it existed before the invention was made—not after.

As previously discussed, the present invention affords the manufacturer the ability to *maximize the impact* of its promotions to targeted consumers at individual retail stores with a *minimum promotions cost* (to the manufacturer). This concept is achieved by coordinating manufacturer price discounts with promotion periods at retail stores. In other words, if the manufacturer wants to offer a select consumer group a certain item for a net sales price of \$1.00, it could choose to do so only during a period when the item is discounted to \$1.50 or less at an individual retail store. In this case, the promotions cost to manufacturer is \$.50 or less. If this is the maximum cost the manufacturer is willing to spend for the promotion, then no manufacturer discount would be provided at all other individual retail stores offering the item for more than \$1.50.

Prior to the invention, no other method had achieved or even suggested this type of coordination or promotion "synergy" between the manufacturer and the retailer. Because the manufacturer cannot dictate ultimate retail sales prices, its promotions costs

¹ Deaton comments briefly (and often in the abstract) on a myriad of possible couponing/discount concepts and features. Of note is the voluminous disclosure of this reference; 65 sheets of drawings and 166 columns of text.

to reach a targeted net price are unpredictable and often uncontrollable. According to the present invention, by conditioning its discounts based on predetermined retail pricing criteria, the manufacturer can effectively control and manipulate its promotions costs to achieve a maximum effective result.

With regard to the "finality" of the present Office Action, the examiner is respectfully requested to review M.P.E.P. Sections 706.07(h)VIII and 706.07(b). According to these sections, it is not proper to make final a first Action in a continuing application where that application contains material which was presented in the earlier application after final rejection, but was denied entry because new issues were raised that required further consideration and/or search. Consequently, Applicant requests that the finality of the present Action be withdrawn.

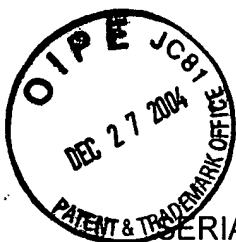
For all these reasons discussed above, Applicant submits that all of the claims in the case are now in condition for allowance. Such action is therefore respectfully requested at an early date. If the Examiner believes that issues remain for discussion, he is invited to contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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APP 3622
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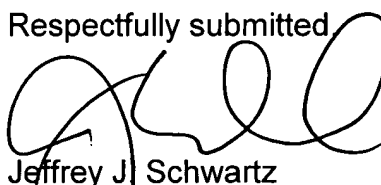
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SUBMISSION OF DOCUMENTS

Sir:

Enclosed please find a Response to be filed in the United States Patent and Trademark Office in the above-referenced patent application. If the accompanying paper is received after any applicable due date, Petition for Extension of Time under 37 C.F.R. §1.136 is hereby made. If there are any fees due in connection with this matter, please charge Applicant's Deposit Account No. 50-2716. A duplicate of this paper is being submitted for this purpose.


Respectfully submitted



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 December 21, 2004.



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